REMARKS

The Examiner is thanked for the performance of a thorough search. By this response, Claims 15–28 and 30–32 are amended. No claims are added or canceled. Hence, Claims 1–32 are pending in this application. The amendments to the claims do not add any new matter to this application and are supported by the Specification as originally filed. The amendments were made solely for the purpose of form and not for any reason related to the merits of the cited references.

All issues raised in the Office Action mailed June 2, 2009 are addressed hereinafter.

I.   INTERVIEW SUMMARY

Applicants thank the Examiner for the telephone interview conducted on September 2, 2009. Examiner McLean and a supervisor from art unit 2625, Supervisor Phoon, represented the USPTO. Applicants were represented by Karl T. Rees. The parties discussed Claim 1, the *Schwier* reference, and the *Warmus* reference. In particular, Applicants pointed out that neither *Schwier* nor *Warmus* teach or suggest the method recited in Claim 1, in that the techniques of *Schwier* and *Warmus* do not involve a <u>first document in a non-merge format and a second document in a merge format</u> as input, nor do the techniques teach or suggest that from these inputs, a "<u>composite merge document</u>" in the merge format is generated. No agreement on the allowability of Claim 1 was reached, however the Supervisor was of the opinion that the references did not appear to teach or suggest the method recited in Claim 1 based on the arguments presented below.

II.   CLAIM REJECTIONS BASED ON 35 U.S.C. § 103

Claims 1–32 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 7,202,972 (hereinafter "*Schwier*") in view of U.S. Patent No. 5,963,968 (hereinafter "Warmus"). Applicants traverse the rejection. Reconsideration is respectfully requested.

CLAIM 1

Claim 1 recites a method useful for, among other purposes, utilizing a merge utility executing at a computer to generate print-ready documents that are in a "merge format" (e.g. PCL, Postscript, etc.). To this end, the merge utility receives two documents—a "first merge document" that is already in a merge format and a "second document" that is in an original format (e.g. a Word document). In response to receiving these two documents, the merge utility causes the second document to be converted to the merge format (e.g. by converting the document itself, or by requesting that another application convert the document). The merge utility then generates a "composite merge document" by combining the first document and the converted second document.

Specifically, the method of Claim 1 features, among other steps:

> receiving . . . a first merge document that is in a merge format;
> converting a second document from an original format to the merge
>   format to create a second merge document;
> . . .
> . . . merging the first merge document and the second merge document to
>   generate a composite merge document; and
> after generating the composite merge document, delivering said composite
>   merge document to an output device;
> . . .
> wherein the original format is a format that is not supported by the output
>   device, and therefore needs to be converted to another format that
>   is supported by the output device in order to be properly
>   interpreted by the output device; and
> wherein the merge format is a format that is supported by the output
>   device, and therefore does not need to be converted to another
>   format that is supported by the output device in order to be
>   properly interpreted by the output device.

By contrast, to the extent relied upon by the Office Action, *Schwier* describes an application 10 which accepts as input variable data 11 and static data 12. *Schwier* at FIG. 1. The application 10 then outputs a single document, V+S 13. Neither the inputs nor the outputs to application 10 are in a merge format.

By further contrast, *Warmus* describes a technique by which a template file is split into two distinct groups of "stripped master page files" and "stripped variable page files," which

distinct groups of files are sent to the printer separately and then merged at the printer. *Warmus* at FIG. 5.

The Office Action is therefore in error for at least the following reasons.

First, the alleged combination still does not yield a "merge utility" that produces a **"composite merge document" in the merge format**. *Schwier*'s APPL 10, alleged to be the merge utility, clearly outputs a document in EMF format (i.e. V+S (EMF) 13), which document is nonetheless alleged to be a composite merge document. The allegation is erroneous. EMF is not a "merge format" within the meaning of Claim 1, as it is not "a format that is supported by the output device." Rather, *Schwier* teaches that V+S (EMF) 13 must be sent to the print spooler or a PCL convertor in order to be converted into a format that is supported by the output device (in this case, PCL).

Second, while the Office Action admits that neither input into application 10 (i.e. variable data 11 and static data 12) is in a "merge format" such as PCL, the Office Action alleges instead that, based on *Warmus*, one skilled in the art would modify either variable data 11 or static data 12 to be in a "merge format." However, there are numerous problems with this alleged combination, including:

- APPL 10 is a "Win-word" utility. To Applicants' knowledge, **no Win Word utility accepts input documents in a merge format** within the meaning of Claim 1.

- There is no teaching that **only one of the input documents is in a "merge format," while the other is not**. *Schwier* shows the use of two documents in non-merge formats as input to APPL 10. *Warmus* shows the division of a document in an alleged merge format into separate documents in alleged merge formats for later combination at the printer. Neither reference shows that one document is in a non-merge format and another is in a merge format.

For at least the foregoing reasons, the combination of *Schwier* and *Warmus* fails to provide the complete subject matter recited in independent Claim 1. Therefore, the combination of *Schwier* and *Warmus* would not have rendered Claim 1 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

INDEPENDENT CLAIM 15

Independent Claim 15 also recites features argued above with relation to Claim 1, although Claim 15 is expressed in another format. Because Claim 15 has at least one of the features described above for Claim 1, Claim 15 is therefore allowable over the combination of *Schwier* and *Warmus* for at least one of the same reasons as given above for Claim 1. Reconsideration is respectfully requested.

DEPENDENT CLAIMS 2–14 AND 16–32

Each of Claims 2–14 and 16–32 depends from Claim 1 or 15, and includes the above-quoted features of its parent claim by dependency. Thus, the combination of *Schwier* and *Warmus* also fails to teach or suggest at least one feature found in Claims 2–14 and 16–32. Therefore, the combination of *Schwier* and *Warmus* does not render obvious Claims 2–14 and 16–32. Reconsideration of the rejection is respectfully requested.

In addition, each of Claims 2–14 and 16–32 recites at least one feature that independently renders it patentable. For example, **Claim 9** recites, among other elements, steps of "generating, based on the original format, **a set of conversion instructions to convert the second document into said second merge document;**" and "**passing the set of conversion instructions from the merge utility to the first document authoring application.**" The Office Action alleges that such steps are taught in *Schwier* at FIG. 2 and column 4, lines 15–20. The Office Action is mistaken, for at least the reason that, while *Schwier* may teach that an application may send conversion instructions to a PCL convertor 18, PCL convertor 18 is not a "first document authoring application." Moreover, the application does not perform this step until after it has merged variable and static data, whereas Claim 9 recites that this step occurs as part of converting the second document prior to merging the first merge document and the second merge document

To expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 2–14 and 16–32 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

III. CONCLUSION

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Date: September 2, 2009   /KarlTRees#58983/
                                  Karl T. Rees, Reg. No. 58,983

2055 Gateway Place, Suite 550
San Jose, CA 95110
(408) 414-1233
Facsimile: (408) 414-1076